

REMARKS

This Response is being submitted in response to the Office Action mailed August 30, 2004. Claims 1-7 stand rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. Claims 1-7 also stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. Claims 1-7 also stand rejected under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter. Applicant respectfully traverses the Examiner's rejections.

Reconsideration of the claims is respectfully requested in light of the remarks below.

I. Claims 1-7, § 112, First Paragraph

Claims 1-7 stand rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. The Examiner states that Applicant does not appear to adequately define the claimed limitation instance data or an instance.

35 U.S.C. § 112 states, in part, “[t]he specification shall contain a written description of the invention...in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains...to make and use the same.” Applicant has described the term “instance” so as to enable person of skill in the art to make and use the invention. The claim term “instance” is adequately defined in the Specification. For example, the definition of the claim term “instance” begins on page 22, “An instance comprises a data point, which represents a specific type of object that possesses certain characteristics or attributes,” continues on page 23, and the term is used and supported throughout the specification.

The Examiner asserts that there are two definitions for the term “instance,” and that “it is unclear as to how the two definitions connect.” See Office Action, page 3. Specifically, “[t]he examiner notes page 4 lines 9-10 of the disclosure makes reference to **classifying data** (otherwise known as [an] **instance**) using a computer system; whereas on page 6 lines 12-13, the disclosure makes reference to *an instance* as being *data*.” See Office Action, page 2 (emphasis in original).

The Applicant respectfully notes that the Office Action incorrectly reads “classifying” as an adjective rather than as a verb, as it is actually used, when citing page 4 lines 9-10. The full sentence in the disclosure reads: “[t]he present invention provides methods for classifying data (otherwise known as an instance) using a computer system.” “[C]lassifying,” read as a verb, is the action that is accomplished by the method, and “data” are the things being classified. Further, the parenthetical “(otherwise known as an instance)” refers only to “data,” i.e., those data which are being classified. The sentence conveys the notion that the present invention provides methods for classifying an instance, which can comprise more than one datum. This definition of “instance” is entirely consistent with the definition cited by the Examiner from page 6 lines 12-13 of the disclosure stating that an instance is data. Moreover, it is entirely consistent with the way “instance” is used throughout the specification.

The Examiner also states that “page 22 lines 14-16 of the disclosure states an ‘overall classification mechanism comprises a computational server 135 first receiving an instance to be classified (the instance comprising at least one attribute value and corresponding relevance value)’; while page 22 lines 24-26 describes an ‘instance comprises a data point, which represents a specific type of object that possesses certain characteristics or attributes.’” See Office Action, page 3 (emphasis in original).

These statements are consistent with each other and with the definition of “instance” as explained above. An “instance” is data, that is, one instance can contain more than one datum. Here, according to lines 14-16, the instance comprises “at least one attribute value and corresponding relevance value.” The attribute value is one datum and the relevance value is another datum; both are contained in the instance described. And according to lines 24-26, “[a]n instance comprises a data point, which represents a specific type of object that possesses certain characteristics or attributes.” In other words, each instance (singular) can represent an object (singular) by inheriting the object’s characteristics (plural) or attributes (plural) as data (plural). The term “instance” is used and supported consistently in this manner throughout the specification.

Thus, the specification complies with the written description requirement, and Applicant respectfully requests that the Examiner withdraw the rejection of claim 1-7 under 35 U.S.C. § 112, first paragraph.

II. Claims 1-7, § 112, Second Paragraph

Claims 1-7 stand rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite. The Examiner states in the Office Action “[r]egarding claim 1, the following limitation is vague: ‘classifying an instance’ [note claim 1 line 1] and an instance [claim 1 line 2].” Claims 2-7 stand rejected on the basis of their dependency from claim 1.

As stated above, the present invention provides a method for classifying an instance, and an instance can comprise more than one datum. The specification supports and uses the term “instance” consistently in this manner. This usage of the term “instance” is clear in claim 1, which reads in full: “[a] method of classifying an instance comprising the steps of: receiving an instance to be classified, the instance to be classified comprising at least one attribute and corresponding relevance value; determining a best host for the instance to be classified; and inserting the instance to be classified into a location relative to at least one child of the best host within a classification structure, the classification structure comprising at least one node, and the node comprising at least one attribute and corresponding relevance value” (emphasis added). The “instance” that is “to be classified” comprises 1) “at least one attribute” and 2) “corresponding relevance value.” Therefore, the instance is a collection of data (plural). “Classification” is what is done to the instance; again, it is important to note that “classifying” is not used as an adjective of “data,” but rather “classifying” is used as a verb to describe the action that is done to the data.

Applicant respectfully believes that once the Examiner notes that “classifying” is used as a verb, and not an adjective, in the text cited by the Examiner, then the removal of this and other rejections under section 112 will be readily removed.

The MPEP states that “[t]he essential inquiry pertaining to this [35 U.S.C. § 112, second paragraph] requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity.” M.P.E.P. § 2173.02.

Respectfully, claim 1 sets out the subject matter claimed with a reasonable degree of clarity and particularity. Claims 2-7 depend from claim 1 and thereby also set out the subject matter claimed with a reasonable degree of clarity and particularity. Applicant respectfully requests that the Examiner withdraw the rejection of claim 1-7 under 35 U.S.C. § 112, second paragraph.

III. Claims 1-7, § 101

Claims 1-7 stand rejected under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter. The Examiner states, "...the claim does not define a useful machine or manufacture by identifying the physical structure of the machine or manufacture." See Office Action, page 5.

Statutory subject matter is defined by 35 U.S.C. § 101, as interpreted by federal case law. According to 35 U.S.C. § 101, "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title." Respectfully, claims 1-7 fall squarely within 35 U.S.C. § 101. When the claimed process produces a "useful, tangible, and concrete result," for example, the claim is directed to patentable subject matter. See *AT&T v. Excel Communications, Inc.*, 172 F.3d 1352, 1359, 50 U.S.P.Q.2d 1447, 1452 (Fed. Cir. 1999), citing *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed.Cir.1998), cert. denied, 525 U.S. 1093, 119 S.Ct. 851, 142 L.Ed.2d 704 (1999). The present claimed process produces a "useful, tangible, and concrete result" in the form of, for example, classification. Therefore, Applicant respectfully submits that the claims are directed to patentable subject matter. The scope of patentable subject matter under 35 U.S.C. § 101 is the same regardless of the form of the claim, machine or process. *AT&T v. Excel Communications, Inc.*, 172 F.3d at 1357, 50 U.S.P.Q.2d at 1451. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claim 1-7 under 35 U.S.C. § 101.

IV. Prior Art Made of Record and Not Relied On

In section 10, the Office lists “[t]he prior art made of record and not relied upon [that] is considered pertinent to applicant's disclosure.” Office Action, page 6. Applicant respectfully reserves the right to present arguments relative to these references, including whether or not they constitute prior art, should the Examiner maintain rejection of Applicant's claims, based upon the references listed or otherwise.

V. Conclusion

Applicants respectfully submit that claims 1-7 are allowable. A favorable Office Action is respectfully solicited.

Should the Examiner have any comments, questions or suggestions of a nature necessary to expedite the prosecution of the application, or to place the case in condition for allowance, the Examiner is courteously requested to telephone the undersigned at the number listed below.

Respectfully submitted,

Date: December 22, 2004

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